

ESTTA Tracking number: **ESTTA552281**

Filing date: **08/05/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	P Swiss, Inc.
Granted to Date of previous extension	08/04/2013
Address	140 Royal Palm WaySuite 202 Palm Beach, FL 33480 UNITED STATES
Attorney information	Casimir W. Cook II Roylance, Abrams, Berdo & Goodman, LLP 1300 19th Street, NWSuite 600 Washington, DC 20036 UNITED STATES CWCdocketing@roylance.com

Applicant Information

Application No	79112749	Publication date	02/05/2013
Opposition Filing Date	08/05/2013	Opposition Period Ends	08/04/2013
International Registration No.	1115471	International Registration Date	03/13/2012
Applicant	OFFICIUM S.r.l. Piazza dell'Indipendenza, 21 I-50129 FIRENZE, ITALY		

Goods/Services Affected by Opposition

Class 014.

All goods and services in the class are opposed, namely: Precious metals, unwrought and semi-wrought; alloys of precious metal; objects of imitation gold, namely, imitation gold jewelry, imitation gold busts, imitation gold boxes; plated articles of precious metal, namely, jewelry plated with precious metals, busts plated with precious metals, boxes plated with precious metals; jewelry, precious stones, statues of precious metal, jade; clocks, watches, chronometrical instruments and parts thereof; watch cases; watch bands; watch straps

Grounds for Opposition

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
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Attachments	60357 - Notice of Opposition 8.5.13.pdf(528376 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Casimir Cook/
Name	Casimir W. Cook II
Date	08/05/2013

60357

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of	:	
Officium S.r.l.	:	
Serial No.: 79/112,749	:	
Filed: March 13, 2012	:	
Mark: PIPPO PEREZ	:	
Published: February 5, 2013	:	

P SWISS, INC.,	:	
Opposer,	:	
v.	:	Opposition No. _____
OFFICIUM S.R.L.	:	
Applicant.	:	

NOTICE OF OPPOSITION

P Swiss, Inc., a corporation organized under the laws of the State of Florida, having a principal place of business at 140 Royal Palm Way, Suite 202 Palm Beach, Florida 33480, (hereinafter called “Opposer”) believes that it is and/or will be damaged by the registration of United States Trademark Application Serial No. 79/112,749 (“the Application”) for PIPPO PEREZ (“Applicant’s Mark”) for “Precious metals, unwrought and semi-wrought; alloys of precious metal; objects of imitation gold, namely, imitation gold jewelry, imitation gold busts, imitation gold boxes; plated articles of precious metal, namely, jewelry plated with precious metals, busts plated with precious metals, boxes plated with precious metals;

jewelry, precious stones, statues of precious metal, jade; clocks, watches, chronometrical instruments and parts thereof; watch cases; watch bands; watch straps,” in International Class 14, (“Applicant’s Opposed Goods”) filed on March 13, 2013 by Officium S.r.l. having an address at Piazza dell'Indipendenza, 21, I-50129 Firenze, Italy (“Applicant”), and, pursuant to Rule 2.101 of the Trademark Rules of Practice and §13 of the Trademark Act of 1946 (15 U.S.C. §1063), hereby opposes the same.

The specific grounds for opposition are as follows:

1. On March 13, 2012, Applicant filed the Application with the U.S. Patent and Trademark Office pursuant to Section 66(a) of the Trademark Act, 15 U.S.C. §1141(f).
2. The Application included Applicant’s declaration pursuant to 15 U.S.C. §1141(5) stating “that the person making the declaration believes the applicant to be entitled to use the mark in commerce; and that to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.”
3. On November 2, 2012, in response to the June 26, 2012 non-final office action in the Application, Applicant submitted a written consent from Giuseppe Perez in which Mr. Perez identified himself as commonly named Pippo Perez and consented to Applicant’s use of PIPPO PEREZ as a trademark in the United States. (Exhibit A).
4. Upon information and belief, Mr. Perez is formally associated with Applicant and its business operations in the United States under the PIPPO PEREZ trademark. (Exhibit B).

5. Opposer and Mr. Perez have had dealings concerning the acquisition and transfer of U.S. trademark rights and domain names previously.

6. Opposer acquired U.S. Trademark Registration No. 2,992,552 – P (Stylized) together with the goodwill of the business symbolized by the trademark via a good faith transfer from Pippo Worldwide, LLC in February 2007. Mr. Perez held a 25% interest in Pippo Worldwide, LLC at the time of the transfer. (Exhibit C).

7. Subsequently, on or around March 2011, Mr. Perez entered into an agreement with Opposer whereby Mr. Perez agreed not to use the designations PIPPO or PIPPO PEREZ in connection with watches, timepieces or similar in the United States.

8. Upon information and belief, since prior to the March 13, 2012 filing date of the Application and Mr. Perez's June 26, 2012 written consent, there existed a legally binding agreement between Opposer and Mr. Perez concerning use of the designations PIPPO and PIPPO PEREZ in connection with watches, timepieces or similar in the United States.

9. Upon information and belief, since prior to the March 13, 2012 filing date of the Application and Mr. Perez's June 26, 2012 written consent, there existed a legally binding agreement between Opposer and Mr. Perez affecting the superiority of rights to the designations PIPPO and PIPPO PEREZ in connection with watches, timepieces or similar in the United States.

10. Upon information and belief, since prior to the March 13, 2012 filing date of the Application and Mr. Perez's June 26, 2012 written consent, Applicant and/or Mr. Perez knew that there existed a legally binding agreement between Opposer and Mr. Perez affecting the superiority of rights to the designations PIPPO and PIPPO PEREZ in connection with watches,

timepieces or similar in the United States. Neither Applicant nor Mr. Perez had any reason to believe otherwise.

11. Upon information and belief, Applicant's March 13, 2012 declaration in support of the Application was false.

12. Upon information and belief, Applicant's March 13, 2012 declaration was a material misrepresentation in that such declaration is a requirement for Section 66(A) applications and but for Applicant's misrepresentation, the application could not be granted registration.

13. Upon information and belief, Mr. Perez's knowledge of the prior agreement concerning use of the PIPPO and PIPPO PEREZ marks in the United States is imputed to Applicant and both Mr. Perez and Applicant must have made the March 13, 2012 declaration with the intent to deceive the U.S. Patent and Trademark Office.

14. Upon information and belief, by withholding these facts from the U.S. Patent and Trademark Office, Applicant and/or Mr. Perez intended to procure a registration to which Applicant was not entitled.

* * * * *

WHEREFORE, Opposer respectfully prays that this Notice of Opposition be granted and sustained, and that the Applicant be refused registration of PIPPO PEREZ for Applicant's Opposed Goods set forth in Application No. 79/112,749.

This Notice of Opposition is submitted electronically through ESTTA, together with payment by credit card in the amount of \$300.00 in payment of the statutory filing fee.

Respectfully submitted,

P SWISS, INC.



Dated: August 5, 2013

Casimir W. Cook II
Roylance, Abrams, Berdo & Goodman, L.L.P.
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Washington, D.C. 20036
Main Telephone: (202) 659-9076
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Attorneys for Opposer

CERTIFICATE OF SERVICE

The undersigned counsel does hereby certify that a copy of the foregoing NOTICE OF OPPOSITION was served upon Applicant's Attorney of Record at Applicant's Attorney's address of record, on the 5th day of August 2013, by first-class mail, postage prepaid, and addressed as follows:

Mark Lebow
Ladas & Parry
Suite 105 1727 King Street
Alexandria, VA 22314



Casimir W. Cook II

Exhibit A

GIUSEPPE PEREZ
CORSO CONCORDIA, 10
20129 MILANO
C.F. PRZ GPP 46R19 F839E

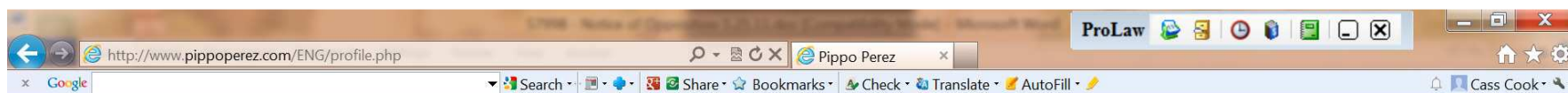
Io, Giuseppe Perez, comunemente chiamato Pippo Perez, confermo il mio consenso all'uso da parte della Officium Srl e alla registrazione come marchio PIPPO PEREZ negli Stati Uniti D'America.

I, Giuseppe Perez, commonly named Pippo Perez, hereby confirm my consent to Officium's use and registration of PIPPO PEREZ as a trademark in United States of America.

FIRENZE. il 26/10/12

Giuseppe Perez


Exhibit B



PIPPO PEREZ

[COMPANY](#) [CONTACTS](#) [EVENTS](#) [NEWSLETTER](#) [SHARE](#) [WEBMAIL](#) [RESERVED AREA](#) [LINES](#) [VIDEO](#)

COMPANY PROFILE

The Company Pippo Perez was born in Florence four years ago from the meeting among Pippo Perez, descendant from a jewelry family whose origins date back to the XV Century, Maurizio Marchi and Michele Capalbo, both deep connoisseurs of the market. The three decided to cooperate and launch a bet in the jewelry sector in order to create precious items not only for grand occasions or to be put away unused in the safety box, but as a daily inseparable companion.

The bet was won thanks to the best shop placing as well as the worldwide customers who confirmed this success.

PIPPO PEREZ



Giuseppe Perez was born in Naples and since he was a child he breaths the air of jewellery, considering his family is known in the jewellery field since XV Century. Thanks to the experience inherited by his father, he stood out among others because of his unique creations which were presented in the most important fairs. Today he designs his jewels branded "Pippo Perez", distributed in the major jewelry stores of the world with Officium.

MAURIZIO MARCHI



Maurizio Marchi made his first moves as sales representative, cooperating for several years with relevant brands in the field and contributing to their growth. He gains a deep knowledge of the best customers all over the world, knowledge that today is put at exclusive disposal of Officium where he heads the commercial area.

MICHELE CAPALBO



Michele Capalbo, accountant doctor, graduated in Economics at the University of Florence, started working as financial director in eminent societies where he enhanced his specific skills which today are at disposal of the society.

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Sito realizzato da [TosNet.it](#)

Exhibit C

Int. Cl.: 14

Prior U.S. Cls.: 2, 27, 28 and 50

Reg. No. 3,518,986

United States Patent and Trademark Office

Registered Oct. 21, 2008

**TRADEMARK
PRINCIPAL REGISTER**

P SWISS

P SWISS, INC. (FLORIDA CORPORATION)
140 ROYAL PALM WAY, SUITE 202
PALM BEACH, FL 33480

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

FOR: WATCHES AND CLOCKS WHICH ARE OF SWISS ORIGIN AS DEFINED BY THE SWISS ORDINANCE GOVERNING THE USE OF THE APPELLATION "SWITZERLAND" OR "SWISS" FOR WATCHES AND JEWELRY , IN CLASS 14 (U.S. CLS. 2, 27, 28 AND 50).

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SWISS", APART FROM THE MARK AS SHOWN.

SER. NO. 77-200,714, FILED 6-7-2007.

FIRST USE 2-21-2007; IN COMMERCE 2-21-2007.

PAM WILLIS, EXAMINING ATTORNEY